Remarks

The examiner has rejected claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,752 to Rivette et al. ("the '752 patent") in view of U.S. Patent No. 6,135,646 to Kahn et al. ("the '646 patent"). These rejections are respectfully traversed.

Applicant has amended claims 1, 3 and 8. Entry of the Amendment, and favorable consideration thereof is earnestly requested.

All of the claims require among other elements, software executing on said Internet server for receiving a transfer request, and software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document.

The examiner has submitted that the '752 patent discloses "software executing on said Internet server for receiving a transfer request" citing the '752 patent col. 22, lines 56 to col. 23, lines 10. However, the '752 patent merely discloses receiving "command request objects" rather than a transfer request as required by all the claims of the present invention. ('752 patent, col. 22, lines 7-8 & 57-61). Instead, the '752 patent teaches that the "command request object" functions include "patent mapping, patent aging, inventor count, inventor information, financial functions" but fails to teach a transfer request of intellectual property. ('752 patent, col. 23, lines 8-10). The "command request object" functions taught in the '752 patent and cited by the examiner relate to the compilation of existing fundamental information variously related to a patent, whereas a transfer request is a command function that will change the existing fundamental information related to a patent. Therefore, because the '752 patent fails to

teach disclose or suggest <u>a transfer request</u> as required by all of the claims of the present invention, it cannot render the claims of the present invention obvious.

The examiner has further submitted that the '752 patent discloses "software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request" citing the '752 patent col. 33, lines 9-46. However, the '752 patent merely discloses receiving "API commands sent from clients" for variously performing grouping functions. ('752 patent, col. 33, lines 2-20). The '752 patent fails to teach, disclose or suggest that that the grouping functions include, software executing on said Internet server for querying said database of information records to retrieve an information record <u>corresponding to a transfer request</u>, for querying said database of recordation forms to retrieve a recordation form <u>corresponding to said transfer request</u>, as required by all the claims of the present invention. Rather, grouping functions discussed in the '752 patent are commands input by a user to directly manipulate a database, whereas in the present invention, the user enters a transfer request and the software queries and gathers various information based upon the transfer request. Once the information based on the transfer request is gathered, the system selects a recordation form, which is again based upon the transfer request. The grouping functions cited by the examiner do not disclose a transfer request command, nor do they disclose that the system makes a determination of the proper forms to utilize based upon a transfer request by a user.

Further, the '752 patent fails to teach combining retrieved information with a <u>retrieved recordation form</u> to generate a document as required by all the claims of the present invention. Again, nowhere does the '752 patent teach that the system determines the proper transfer forms to be utilized corresponding to a transfer request.

Therefore, because the '752 patent fails to teach, disclose or suggest, software executing on said Internet server for querying said database of information records to retrieve an information record <u>corresponding to a transfer request</u>, for querying said

database of recordation forms to retrieve a recordation form <u>corresponding to said transfer request</u>, and for combining the retrieved information record with the <u>retrieved recordation form</u> to generate a document, as required by all of the claims of the present invention, it cannot render the claims of the present invention obvious.
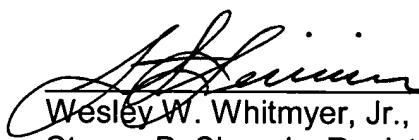
The examiner has submitted that the '646 patent discloses querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document. The '646 patent is generally directed towards a system for enabling holders of rights in digital objects to control terms and conditions under which they are accessed by users on a network. ('646 patent, abstract). The '646 patent further discloses that the system operations "include registration of rights, recordation of transfers of rights." However, the '646 patent fails to teach, "software executing on said Internet server ... for querying said database of recordation forms to retrieve a recordation form <u>corresponding to said transfer request</u>, and for combining the retrieved information record with the <u>retrieved recordation form</u> to generate a document." Rather, the '646 patent discloses that the "workstation interacts with the registration system to obtain registration application information, with the rights management systems and repositories to obtain digital objects whose rights are being registered, and with the recordation system to obtain recordation information and associated documents." ('646 patent, col. 8, lines 50-55). Nowhere does the '646 patent teach that the system chooses the appropriate transfer documents corresponding to the transfer request, rather it teaches that the "workstation 50 allows a registrar user to view and print rights registration applications and accompanying documents and recordation information and accompanying documents." ('646 patent, col. 8, lines 47-50). Hence, rather than the system retrieving forms corresponding to the transfer request (the system determines the appropriate form, not the user) as required by all the claims of the present invention, the '646 patent system teaches that retrieved information is merged into documents the user selects.

Therefore, because the '646 patent fails to teach, disclose or suggest, "software executing on said Internet server ... for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document", as required by all of the claims of the present invention, it cannot render the claims of the present invention obvious.

In addition, because neither the'752 patent nor the '646 patent teach, disclose or suggest "software executing on said Internet server ... for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document", as required by all of the claims of the present invention, no combination of the two references can render the claims of the present invention obvious.

It is respectfully submitted that claims 1-10, all of the claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,

Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. P-54,449
Attorney for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155